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In re Application of
KERN, Andrea *et al*
U.S. Application No.: 08/637,752
PCT No.: PCT/EP94/03564
Int. Filing Date: 28 October 1994
Priority Date: 28 October 1993
Attorney Docket No.: 8484-013-999
For: ADENO-ASSOCIATED VIRUS - ITS DIAGNOSTIC USE WITH EARLY ABORTION

DECISION

This decision is in response to applicants' "Renewed Petition Under 37 CFR 1.137(b)" ("Ren.Pet.") purportedly originally filed 18 September 2000 and again via facsimile on 15 November 2000 and by messenger on 16 November 2000.

BACKGROUND

On 15 February 2000, a decision dismissing applicants' renewed petition under 37 CFR 1.137(b) was mailed because of a failure to provide a proper terminal disclaimer. Applicants were given two months to respond.

On or about 20 August 2000, counsel, Birgit Millauer, contacted James Thomson, PCT Legal asking about the decision to the renewed petition to revive filed 08 December 1999 on the above-captioned application. Mr. Thomson responded that the decision was mailed 15 February 2000. Counsel requested a facsimile copy of the decision which was sent 07 September 2000.

On 18 September 2000, applicant purportedly filed a "Renewed Petition Under 37 CFR 1.137(b)" which was accompanied by, *inter alia*, a corrected terminal disclaimer and fee, a "Declaration of Carolyn Garcia" ("Garcia Decl."), and copies of the law firm's mail log from 15 February 2000 through 31 May 2000. These papers are currently not located in the above-identified file.

On 15 November 2000, applicants filed via facsimile copies of the documents purportedly filed 18 September 2000 excluding the mail logs.

On 16 November 2000, applicants submitted copies of the documents purportedly filed 18 September 2000 including all of the mail logs via a messenger.

DISCUSSION

Present Petition Mailed 18 September 2000

Applicant claims that the instant response was originally submitted 18 September 2000. Section 503 of the Manual of Patent Examining Procedure ("MPEP") lists procedures for applicants to ensure receipt of any paper filed in the PTO. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

In this case, applicants have provided a copy of their date-stamped filing receipt. The receipt clearly identifies the application and all papers submitted with the U.S. application number, attorney docket number and title. The postcard filing receipt acknowledges that an assignment, petition under 37 CFR 1.137(b), terminal disclaimer and copies of mail logs from 15 February 2000 to 31 May 2000 were received in the PTO on 18 September 2000. The receipt is stamped "OIPE SEP 18 2000" across its face. Accordingly, applicant has provided *prima facie* evidence that the instant papers submitted via a messenger on 16 November 2000 were originally filed on18 September 2000.

Nonreceipt of Decision

The decision dated 15 February 2000 gave applicant two months to provide a proper response. Applicant could request an extension of time pursuant to 37 CFR 1.136. However, applicant did not respond until 18 September 2000.

Applicant claims that the decision was never received via first class mail and that they did not learn of the decision until Birgit Millauer telephoned James Thomson of the PCT Legal Office on or about 20 August 2000.

The showing required to establish the failure to receive an Office communication (set forth in section 711.03(c) of the MPEP, page 700-87 (Rev. 1 Feb. 2000) must consist of: (1) a statement from the practitioner declaring that the Office communication was not received by the practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and, (3) a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioners' statement.

In the instant response, counsel states that "[a]pplicants did not receive the decision via first class mail." Ren.Pet. ¶ 3. This statement satisfies item (1).

With regards to item (2), applicant submitted a "Declaration of Carolyn Garcia" the Docket Supervisor in the Records and Docketing department of the New York office of Pennie & Edmonds LLP where the 15 February 2000 decision was mailed. Ms. Garcia explained the firm's docketing procedure and that the firm uses a computerized daily tickler record. Ms. Garcia states that the New York office enters PTO correspondence in a mail log on the date in which it is received, a copy is made of each piece of correspondence and kept in the Docketing Department, and that all PTO correspondence is docketed in the computerized docketing system, on the file itself, and on the correspondence itself. Moreover, Ms. Garcia says that a "review of the files (Pennie & Edmonds LLP docket no. 8484-13) did not reveal the Decision dated February 15, 2000." Garcia Decl. ¶ 5. Also, Ms. Garcia claims that "I checked the mail log" and that the "search did not identify a copy of the Decision, dated February 15, 2000." Id. at ¶ 6. Furthermore, she "checked the computer docketing system and no indication of the Decision being received is there." Id. at ¶ 7. Finally, Ms. Garcia concludes that there "is no indication in any of our records . . . that the Decision was ever received." Id. at ¶ 8. These statements satisfy item (2).

Concerning item (3), applicants submitted copies of the law firm's mail logs from 15 February 2000 through 31 May 2000 where official PTO correspondence is entered on the date in which it was received. A review of these logs do not show that the aforementioned decision was received. Nevertheless, applicants must also provide a copy of the computer docket record for the above-captioned file so the Office can verify that the decision was never received. Until receipt of these records, applicants have not sufficiently established nonreceipt of the 15 February 2000 decision.

Petition to Revive

A petition under 37 CFR 1.137(b) requesting to revive an application on the grounds of unintentional delay must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). Items (1), (2) and (3) have previously been satisfied.

With regards to item (4), 37 CFR 1.137(c) states, in part:

> Any terminal disclaimer pursuant to this paragraph must also apply to any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

This time the terminal disclaimer submitted does not limit its application to 35 U.S.C. 120 benefits, but also to 35 U.S.C. 121 and 365(c) benefits. The statutory disclaimer fee was previously submitted. Thus, item (4) is satisfied. Accordingly, all the requirements of 37 CFR 1.137(b) are completed. However, applicants failed to meet the requirements of 37 CFR 1.137(d). Section 711.03(d)(III)(H) states in part:

> 37 CFR 1.137(d) specifies a time period within which a renewed petition pursuant to 37 CFR 1.137 must be filed to be considered timely. Where an applicant files a renewed petition, request for reconsideration, or other petition seeking review of a prior decision on a petition pursuant to 37 CFR 1.137 outside the time period specified in 37 CFR 1.137(d), the Office may require, inter alia, a specific showing as to how the entire delay was "unavoidable" (37 CFR 1.137(a)) or "unintentional" (37 CFR 1.137(b)).

Here, satisfying the requirements outlined above regarding nonreceipt of an office action would be an acceptable response.

CONCLUSION

The renewed petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

Since a grantable petition to revive has not been filed, the international application remains **ABANDONED** as to the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." Applicants are advised that extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

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Express Mail No. EL 451 595 035 US
Date Mailed 18 September 2000 First Class Mail ( )
Ser. No. 08/637,752
Inventor Kern et al. Filed 29 April 1996
For ADENO-ASSOCIATED VIRUS-ITS DIAGNOSTIC USE WITH EARLY ABORTION

(X) ~~Affidavit~~/Declaration of Carolyn Garcia
( ) Amendment
( ) Application____Pages
( ) ____ Claims ____ Drawings
( ) Appeal, Notice of
(XX) Assignment (copy)
( ) Brief (in triplicate)
( ) Declaration & Power of Attorney
( ) Design Application
( ) Disclaimer
( ) Disclosure Statement
( ) w/refs. ( ) w/o refs.
( ) Drawings Formal
____Sheets ____Figures

( ) Fee Address Indication Form
( ) Fee Calculation
( ) Issue Fee Transmittal
( ) Letter
( ) Oral Hearing Req./Confirm.
( ) Petition to Extend Time
(XX) Pet. under 37 C.F.R. 1.137(b) (dupl) RENEWED
( ) Power of Attorney
____Associate____w/Revocation
( ) Sequence Listing w/Computer Readable and Paper Copies
( ) Small Entity Statement
( ) Status Letter
( ) Transmittal Letter

Other: Terminal Disclaimer (dupl); Exhibit 1 copies of mail logs from 2/15/00-5/31/00; Return Post Card
File No. 8484-013-999 Sender: LAC/BBM/jwc